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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,835	04/15/2004	Julia B. Mark	P1102.14005	8773

30615 7590 08/23/2004

BIRDWELL, JANKE & DURANDO, PLC
1100 SW SIXTH AVENUE
SUITE 1400
PORTLAND, OR 97204

EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,835

Applicant(s)

MARK, JULIA B.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 15, 16, 24, 28, 32, 38, 42 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 24 and 44, "the same size and shape" lacks proper antecedent basis.

In claims 2, 3, 15 and 16, "the images" and "the text" lack proper antecedent basis.

In claims 28, 32, 38 and 42, it is not clear how the method of finding an animal or plant and comparing it with the picture further limits the method for carrying and viewing information.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Grant (5,291,755).

Grant discloses a wearable book (10) comprising a plurality of pages (18) connected to a loop (20), wherein the pages are of substantially the same size and shape and having corresponding first edges and the pages being bound together at the first edges (as seen in figure 1).

It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Therefore, the reference applied is only required have the ability to perform the claimed function. In this case, the wearable book of Grant is capable of encircling a first body portion for attaching the pages to the body.

Regarding claims 2 and 3, the pages are constructed of a weather-resistant material (see col. 2, lines 42-50).

6. Claims 24, 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Vogel (3,087,498).

Vogel discloses a method for carrying and viewing information comprising providing a plurality of pages (22) of substantially the same size and shape having corresponding first edges; binding the pages at the first edges to a loop (24) and encircling first and second portions of the body with the loop (the key chain loop 24 is capable of encircling a hand (first portion) and wrist (second portion) of a person).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4-12 and 14-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grant.

Regarding claims 4 and 5, Grant discloses the claimed invention except for the pages being made of synthetic paper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the pages of any desired material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 6-11 and 19-23, Grant discloses the claimed invention except for the specific arrangement and/or content of indicia (picture of an animal, plant, fungus, astronomical object, rock or mineral or foreign language) set forth in the

claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the pages, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of book does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding claims 12 and 14, Grant discloses the claimed invention except for the claimed elasticity of the loop. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any elasticity value for the loop, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claims 15 and 16, see the above rejections to claims 2 and 3.

Regarding claims 17 and 18, see the above rejections to claims 4 and 5.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grant in view of Wada (4,642,054).

Grant discloses the claimed invention as set forth in the above rejections to claims 1 and 12 except for the loop being an elastic loop formed of plastic in a helical, spring-like configuration.

Wada discloses a picture book comprising a helical, spring-like configuration (as seen in figure 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Grant's invention by replacing the loop with an elastic loop formed of plastic in a helical, spring-like configuration, as taught by Wada, to provide the loop with a greater flexibility such that it may be encircled around larger items.

10. Claims 25-33 and 36-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogel in view of Grant, as used above.

Regarding claims 25, 26, 29, 33, 36, 39 and 43, Vogel discloses the claimed invention except for the pages being resistant to environmental factors.

Grant discloses a wearable book (10) comprising a plurality of pages (18) connected to a loop (20), wherein the pages are constructed of a weather-resistant material (see col. 2, lines 42-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Vogel's device to include weather-resistant material, as taught by Grant, to protect the device from inclement weather.

Regarding claims 27, 28, 30, 31, 32, 37, 38, 40, 41 and 42, Vogel, as modified by Grant, discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the pages, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of book does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding claims 44 and 45, Vogel, as modified by Grant, discloses binding the pages together and then binding them to the loop.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose books.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (6:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 19, 2004

Monica S. Carter
MONICA S. CARTER
PRIMARY EXAMINER